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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RAMILLANO, LORE JANET

ART UNIT

PAPER NUMBER

1743

MAIL DATE

DELIVERY MODE

08/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/743,263	Applicant(s) SIEBEN, ULRICH	
	Examiner Lore Ramillano	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-46 is/are pending in the application.
- 4a) Of the above claim(s) 12-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-11,45 and 46 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/6/07 has been entered.

Status of Claims

2. In applicant's reply filed on 6/6/07, applicant amended claims 1, 11, and 45-46; and cancelled claim 6. Claims 12-44 are withdrawn. Claims 1-2, 4-5, 7-11, and 45-46 are under examination.

Response to Amendment

Claim Rejections - 35 USC § 112

3. The rejection of claims 1-2, 4-11, and 45-46, under 35 U.S.C. 112, second paragraph, is withdrawn. However, in light of applicant's amendments, a new rejection follows.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-2, 4-5, 7-11, and 45-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 1 and 45, the claim language, "where the substances are disposed differently in the defined regions on two different carrier media," makes these claims indefinite because applicant's preamble recites having one carrier medium and now applicant is implying that the carrier medium comprises having another carrier medium. This makes the claim confusing. Examiner recommends amending the preamble to recite, for example, "Two different carrier media for analyzing an analyte, comprising."

Claim Objections

6. Claim 7 is objected to because of the following informalities: does applicant mean to recite "each" instead of "which" in claim 7. Appropriate correction is required.

Prior art rejections

7. The rejection over Zeleny is withdrawn, and the rejection over Woods is maintained. In light of the new amendments, new rejections follow.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1-2, 4, 7-11, 45, and 46** are rejected under 35 U.S.C. 102(b) as being anticipated by Zeleny et al. ("Zeleny," US 6215894).

Zeleny discloses a carrier medium (i.e. 10, fig. 1) for analyzing an analyte, comprising: a plurality of defined regions (i.e. 12 and 14, fig. 1), where each of the defined regions has one of a plurality of different substances (i.e. column 2, line 66 to column 3, line 7); and a code (i.e. 16, 18, fig. 1; column 2, lines 13-33) that indicates which one of the substances is applied in which one of the defined regions, where the substances are disposed differently in the defined regions on two different carrier media (i.e. column 3, lines 1-7), where the code (i.e. 16, 18, fig. 1) is from the group that comprises a bar code, a numeric code, an alphanumeric code, and an arrangement of the plurality of defined regions on the carrier medium.

Zeleny further discloses the following: where several hundred substances are applied in a corresponding number of the defined regions (i.e. column 2, line 66 to column 3, line 7); where the defined regions are disposed differently on two different carrier media (i.e. column 2, line 66 to column 3, line 7; column 4, lines 25-31); where the code provides information for a device reading the carrier medium as to how the device should read which of the defined regions (i.e.); where the code contains information on the expiration date of the carrier medium (i.e. column 3, lines 8-18); where the code contains information on the storage of the carrier medium from the time the carrier medium is manufactured until the time the carrier medium is used (i.e. column 3, lines 8-18); where the carrier medium comprises a material from the group that includes a film strip, glass carrier, or paper (i.e. microscope slide is made of glass, column 2, lines 66-67); where the plurality of substances are from the group comprising

biological substances and chemical substances, and where the group includes DNA, RNA, proteins, and antibodies (i.e. column 1, lines 13-57).

10. **Claims 1-2, 4-5, 7-11, 45, and 46** are rejected under 35 U.S.C. 102(e) as being anticipated by Woods (US 2003/0177380).

Woods discloses a carrier medium (i.e. 112 and 110, fig. 3) for analyzing an analyte, comprising: a plurality of defined regions (i.e. 116, fig. 3), where each of the defined regions has one of a plurality of different substances (i.e. bioloymers, e.g. in the form of polynucleotides, [0075]); and a code (i.e. 8, fig. 1A) that indicates which one of the substances is applied in which one of the defined regions, where the substances are disposed differently in the defined regions on two different carrier media (i.e. [0074]), where the code is from the group that comprises a bar code, a numeric code, an alphanumeric code, and an arrangement of the plurality of defined regions on the carrier medium.

Woods further discloses the following: where several hundred substances are applied in a corresponding number of the defined regions (i.e. [0065]-[0068]); where the defined regions are disposed differently on two different carrier media (i.e. [0074]); a temperature sensor (i.e. 4, fig. 1A); where the code provides information for a device reading the carrier medium as to how the device should read which of the defined regions (i.e. [0022]-[0024]); where the code contains information on the expiration date of the carrier medium (i.e. [0024]); where the code contains information on the storage of the carrier medium from the time the carrier medium is manufactured until the time the carrier medium is used (i.e. [0023]-[0024]); where the carrier medium comprises a

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material from the group that includes a film strip, glass carrier, or paper (i.e. [0069]-[0072]); where the plurality of substances are from the group comprising biological substances and chemical substances, and where the group includes DNA, RNA, proteins, and antibodies (i.e. [0065]-[0068]).

11. **Claims 1-2, 4-5, 7-11, 45, and 46** are rejected under 35 U.S.C. 102(e) as being anticipated by Sheridan et al. ("Sheridan," US 2003/0027342).

Sheridan discloses a carrier medium (i.e. 106, fig. 5) for analyzing an analyte, comprising: a plurality of defined regions (i.e. 504, fig. 5), where each of the defined regions has one of a plurality of different substances (i.e. [0030], [0048]); and a code (i.e. 412, fig. 5) that indicates which one of the substances is applied in which one of the defined regions, where the substances are disposed differently in the defined regions on two different carrier media (i.e. [0048]), where the code (i.e. 412, fig. 5) is from the group that comprises a bar code, a numeric code, an alphanumeric code, and an arrangement of the plurality of defined regions on the carrier medium.

Sheridan further discloses the following: where several hundred substances are applied in a corresponding number of the defined regions (i.e. [0030], [0048]); where the defined regions are disposed differently on two different carrier media (i.e. [0029], [0048]); a temperature sensor (i.e. [0031]); where the code provides information for a device reading the carrier medium as to how the device should read which of the defined regions (i.e. [0047]); where the code contains information on the expiration date of the carrier medium (i.e. [0047]); where the code contains information on the storage of the carrier medium from the time the carrier medium is manufactured until the time

the carrier medium is used (i.e. [0047]); where the carrier medium comprises a material from the group that includes a film strip, glass carrier, or paper (i.e. microscope slides are generally made of glass, [0030]); where the plurality of substances are from the group comprising biological substances and chemical substances, and where the group includes DNA, RNA, proteins, and antibodies (i.e. [0030]).

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Zeleny et al. ("Zeleny," US 6215894) in view of Woods.

The disclosure of Zeleny is disclosed above. Zeleny does not specifically disclose a temperature sensor.

As disclose above, Woods discloses a device comprising an array holder (2, Fig. 1A), which includes one or more measuring sensors, such as a temperature sensor (4, Fig. 1A). It would be desirable to know the temperature of a single or multiple arrays to optimize the reaction conditions.

It would have been obvious to a person of ordinary skill in the art to modify Zeleny by incorporating the temperature sensor of Woods because knowing the temperature of a single or multiple arrays would optimize the reaction conditions and ensure that the reaction conditions occurring on Woods array is occurring within an acceptable temperature range.

Response to Arguments

14. Applicant's arguments, filed on 6/6/07, with respect to claims 1-2, 4-5, 7-11, 45, and 46 over Zeleny in view of Woods have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments, filed on 6/6/07, with respect to claims 1-2, 4-5, 7-11, 45, and 46 by Woods have been fully considered but they are not persuasive with regard to Woods.

In response to applicant's argument that Woods fails to disclose the feature of the amended claim 1 of "where the substances are disposed differently in the defined regions on two different carrier media," examiner disagrees. Woods properly reads on applicant's claim language because Woods discloses in paragraph [0074] having more than carrier media (112, fig. 3) which are the same or different and in paragraph [0075] that the defined regions (116, fig. 3) are the same or different.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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